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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,004

02/01/2005

Toni Stadelmann

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OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER

BHATTACHARYA, SAM

ART UNIT

PAPER NUMBER

2617

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/523,004	STADELMANN ET AL.	
	Examiner	Art Unit	
	Sam Bhattacharya	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>see attached 1449</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claims 7 and 8 are objected to because of the following informalities: <sic. first> and <sic. second> in lines 2 and 5 of claim 7, and <includes> in line 10 of claim 8 appear to be in error. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kalvade et al. (US 7,171,460).

Regarding claim 1, Kalvade discloses a computer-aided method and system for recording and billing of services during roaming of a mobile IP node 16 in FIG. 2 in heterogeneous

WLANs, the mobile IP node accessing an access point 101 in FIG. 15 of a WLAN within a basic service area of a WLAN via a wireless interface, the basic service area of the WLAN including one or more access points 101 assigned to an access server 10 in FIG. 2, at which the mobile IP node, upon request of the access server, transmits to the access server an IMSI stored on an SIM card of the mobile IP node (col. 32, lines 65-66), and the IMSI of the IP node is stored in a database of an SIM-RADIUS module, characterized in that by means of an SIM user database and an SIM gateway module, an SIM-RADIUS module supplements user-specifically the logical IP data channel of the WLAN toward corresponding GSM data for signal and data channels of a GSM network (col. 7, lines 22-38, col. 11, lines 59-60), the authentication and/or service authorization of the mobile IP node being carried out at an HLR and/or VLR of a GSM network, based on the IMSI of the SIM card of the mobile node (col. 13, lines 14-16, col. 17, lines 34-43), in that by means of a billing gateway interface a billing module accesses the access server, first call detail records of the mobile IP node being transmitted from the access server to the billing module, and the billing gateway interface including an assigned billing management database with the configuration profile of each access server (col. 18, lines 7-28), in that second call detail records of the mobile IP node are transmitted to a proxy module, which proxy module captures at least the identity of the mobile IP node and/or duration and/or provider of the obtained service and passes it on to the billing module, and in that the billing module generates TAP files corresponding to the obtained service, based on the data of the proxy module and the first call detail records (col. 35, lines 15-17), and transmits these together with billing instructions to a clearing module, the billing instructions including at least user-specific and/or service-provider-specific billing data, and the clearing module billing the service obtained by the user to a

provider of a fixed network and/or transmitting the TAP files to a GSM service provider for billing (col. 18, lines 45-61).

Regarding claim 2, Kalvade discloses that a first call detail record is created based at least on the IP address of the mobile IP node and identifications of the service provider whose service was obtained by the mobile node. See col. 32, lines 65-66.

Regarding claim 3, Kalvade discloses that the data stream of the mobile node when accessing the WLAN from the access point is directed via a mobile radio network service provider. See col. 7, lines 22-38, col. 11, lines 59-60.

Regarding claim 4, Kalvade discloses that the TAP files are created based at least on Inter Operator Tariffs and Public Mobile Network TAP identification codes. See col. 35, lines 15-17.

Regarding claim 5, Kalvade discloses that the billing management database includes IP addresses and/or GSM identification of the users and/or service providers. See col. 7, lines 22-38, col. 11, lines 59-60.

Regarding claim 6, Kalvade discloses that the billing management database includes Inter Operator Tariffs and Public Mobile Network TAP identification codes. See col. 35, lines 15-17.

Regarding claim 7, Kalvade discloses that the first SIM-based call detail records of the mobile IP node are transmitted from the access server to the billing module and the second IP-based call detail records from the access server to the proxy module. See col. 18, lines 45-61.

Claims 8-14 correspond to claims 1-7, and are therefore rejected for the same reasons as claims 1-7.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/522,767.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims recite WLANs, a mobile IP node accessing an access point, an IMSI stored in a SIM card, a database of a SIM-RADIUS module, a GSM network, performing authentication of the mobile IP node at an HLR/VLR of the GSM network, with minor variations in claim language.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reifer et al. (US 6421727).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Bhattacharya whose telephone number is (571) 272-7917. The examiner can normally be reached on Weekdays, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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